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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
043311-0313722

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Typed or printed name _____

Application Number	Filed
09/461,336	December 15, 1999

First Named Inventor
DAZHI CHEN

Art Unit	Examiner
3627	SHEIKH, Asfand M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 54,806
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

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January 21, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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A. ATTACHMENT SHEETS TO PRE-APPEAL BRIEF CONFERENCE REQUEST

Appellant is appealing the rejections of: (i) claims 1-10, 14-16, 23-45, 49-51, 58-81, 84-98, 100, 102-112, 115-129, 131, 133, 134 and 136-153 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 5,803,500 to Mossberg ("Mossberg") in view of U.S. Patent No. 5,909,673 to Gregory ("Gregory") and U.S. Patent No. 5,845,265 to Woolston ("Woolston"); (ii) claims 147 and 148 under 35 U.S.C. § 103 as allegedly being unpatentable over Mossberg in view of Gregory and Woolston and further in view of the Official Notice taken; and (iii) claims 149-153 under 35 U.S.C. § 103 as allegedly being unpatentable over Mossberg in view of Gregory and Woolston and further in view of U.S. Patent No. 6,112,181 to Shear et al. ("Shear").

A. Claim 1 is patentable under 35 U.S.C. § 103(a) over Mossberg, Gregory, and Woolston, either alone or in combination.

1. Mossberg, Gregory, and Woolston fail to teach (i) a business having peak and non-peak demand periods; and (ii) and an item that is redeemable for the service from a businesses during the non-peak demand period to obtain a discount from the predetermined price of the item during the non-peak demand period.

The Examiner *acknowledges* that "Mossberg fails to disclose ... [that] the discounted gift certificates are redeemable for the service from a corresponding one of the one or more restaurants during the non-peak demand period."[1] However, the Examiner alleges that Gregory teaches providing coupons that are redeemable for the service during non-peak demand periods to reduce excess capacity during non-peak demand periods.[2] The Examiner has legally erred for *at least* the reason that the Examiner mischaracterizes Gregory.

The relied-upon passage of Gregory discloses:

> The hardware used to implement the system described above can also be used to distribute site specific coupons. Site specific coupons are coupons targeted to the requirements of individual stores including specific details like the amount of the discount on the coupon, the days and hours the coupon is valid, the location at which the coupon is valid, the expiration date

[1] Office Action, pgs. 3-4.

[2] *See* Office Action, pgs. 4-5 (*citing* col. 6, lines 54-67 of Gregory).

> of the coupon, and the product to which the coupon applies. In the prior art method of distributing coupons the needs of individual stores cannot be taken into account. The present invention allows retailers or restaurants to customize coupons for specific locations. For example, ***if a certain product does not sell well at a particular location a coupon can be distributed that provides a greater discount at that location than the discount provided at other locations***.[3] (emphasis added)

Gregory focuses on using coupons for different locations. To the extent that Gregory provides businesses with the ability to set "the days and hours the coupon is valid," Gregory makes no mention or suggestion that these periods are non-peak demand periods of businesses, as claimed. For example, the days and hours that a coupon is valid may correspond to the hours of operations of the business. Gregory further teaches the businesses may provide discounts on products not selling well, but this is done on a location-by-location basis, not on a temporal basis. These are not the same. Gregory does not disclose any solutions for businesses to reduce excess capacity *during non-peak demand periods*. Thus, it does not follow that Gregory teaches or otherwise renders obvious enabling businesses to reduce excess capacity during the non-peak demand periods using coupons redeemable at non-peak tim.

Woolston does not overcome these deficiencies, either, as further discussed below.

For *at least* the foregoing reasons, the rejection of claim 1 is improper and should be withdrawn.

2. Mossberg, Gregory, and Woolston fail to teach enabling one or more businesses to post on the web-site one or more items for auction wherein the one or more businesses provide, at the time of the post, valid dates and times for use of the one or more items to reduce excess capacity during the non-peak demand period.

The Examiner *acknowledges* that "Mossberg in view of Gregory fails to disclose enabling one or more restaurants to post on the web site a listing of one or more discounted gift certificates being offered for sale and further information regarding valid

[3] Gregory, col. 6, lines 54-67.

dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand periods at the time of the post ..."[4] However, the Examiner asserts that Woolston teaches listing descriptive information at the time of the post and that "... the descriptive information is a matter of design choice (e.g., valid dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand period)."[5] The Examiner has legally erred for *at least* the reasons that (i) the Examiner ignores the plain language of the claim; (ii) fails to consider the "subject matter as a whole," under 35 U.S.C. § 103; and (iii) the recitation is not a matter of design choice.

Claim 1 does not just recite that businesses provide, at the time of post, any descriptive information regarding the item. Rather, claim 1 specifically recites "enabling one or more businesses to post on the web-site one or more items for auction ***wherein the one or more businesses provide, at the time of the post, valid dates and times for use of the one or more items to reduce excess capacity during the non-peak demand periods***." Indeed, "[t]he [Examiner] must consider all claim limitations when determining patentability of an invention over the prior art."[6] Even if the recitation might include descriptive matter (which Appellant does not concede), it is improper to disregard a recitation, just because it might be comprised of descriptive matter.[7]

As such, the Examiner's treatment of the recitation fails to consider the subject matter as a whole. "Under section 103, the [Examiner] cannot dissect a claim, excise the [descriptive] matter from it, and declare the remaining portion of the mutilated claim to be unpatentable."[8] Indeed, the Examiner must give patentable weight to the descriptive matter where the descriptive matter and the claimed invention are so interrelated that there is a functional relationship between the descriptive matter and the claimed invention.[9] In fact, claim 1 also recites that "the winner and one or more

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[4] Office Action, pg. 5.

[5] *Id.* pg. 5; *see also* pgs. 6-7 (similar treatment of the features of claims 136 and 138).

[6] *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1021, 1034 (Fed. Cir. 1994) (citation omitted).

[7] *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (Fed. Cir. 1983).

[8] *Id.*

[9] *See, e.g., Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004); *Gulack*, 703 F.2d at 1385, 217 USPQ at 404; *In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 48-49 (CCPA 1969).

purchasers of the item obtain a discount from the predetermined price during ***the non-peak demand period*** and non-winners and non-purchasers pay the predetermined price without the discount during ***the non-peak demand period.***"[10] Thus, when posting, businesses specifically inform users of the dates and times that items are redeemable at a discount. Without this information, users would not be apprised of time-sensitive discounts.

The prior art does not teach or render obvious these features. For example, Woolston is silent in regard to enabling businesses to provide, at the time of the post, valid dates and times for use of the one or more items to reduce excess capacity during the non-peak demand periods. To the extent that the system of Woolston enables providing a date or time, at the time of a post, it is the date and time at which an auction for the item posted is to occur.[11] This is not relevant to reducing excess capacity that businesses face during non-peak demand periods.

By contrast, according to Appellant's claimed invention, it is the recognition that for different business and restaurants peak and non-peak demand periods may vary that the invention provides a flexible system for businesses (and restaurants) to establish the dates and times that users can obtain a discount corresponding to the non-peak demand periods. According to a further aspect of the invention, a web-site is provided that enables businesses to post items for auction or instant purchase, such that auction winners and instant purchasers can obtain a discount from the predetermined price during non-peak demand periods. This provides businesses with a greater ability to reduce excess capacity during off-peak times. Thus, the recitation is not an obvious matter of design choice.[12]

For *at least* the foregoing reasons, the rejection of claim 1 is improper and should be withdrawn.

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[10] The preamble of the claim 1 also recites: "A computer implemented method of using a web-site for ***reducing excess capacity during non-peak demand periods*** for a service business ***that experiences periods of peak demand and periods of non-peak demand for a service*** that is offered at a predetermined price ..." (emphasis added).

[11] *See* Woolston, col. 5, lines 60-62; col. 6, lines 3-5.

[12] *See In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-96 (Fed. Cir.1995) (holding only if applicant fails to set forth any reasons why the differences between the claimed invention and the prior art would result in a different function or give unexpected results, might the differences be a matter of design choice).

B. The remaining rejected claims are also patentable under 35 U.S.C. § 103(a).

Independent claims 71 recites subject matter similar to independent claim 1, but recites "certificates," not just items. In addition, independent claim 133 recites subject matter similar to independent claim 1, but is directed more narrowly to "reducing capacity for one or more restaurants," not just businesses, and recites "gift certificates" rather than items. Independent claims 36, 102 and 153 recite system recitations substantially corresponding to the method steps of independent claims 1, 71 and 133, respectively.

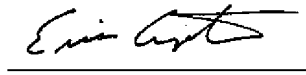
For reasons that should be quite apparent from the discussion of independent claim 1, above, Mossberg, Gregory, and Woolston, either alone or in combination, do not teach or otherwise render obvious these features of independent claims 36, 71, 102, and 133. As for independent claim 153, Shear does not overcome the deficiencies of Mossberg, Gregory, and Woolston, noted above, either. Dependent claims 2-10, 14-16, 23-45, 49-51, 58-81, 84-98, 100, 102-112, 115-129, 131, 133, 134 and 136-153, are patentable because they depend from the patentable independent claims 1, 36, 71, 102, 133 and 153, as well as for the additional features they recite individually.

* * *

For *at least* the foregoing reasons, it is respectfully requested that the panel return a decision concurring with Appellant's position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections. Thus, the rejections should be withdrawn and the claims be allowed.

Date: **January 21, 2009**

Respectfully submitted,

By: 

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